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| 29159 7590 01/07/2009 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690 | | | | |
| EXAMINER RENWICK, REGINALD A | | | | |
| ART UNIT 3714 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/539,848

Applicant(s)

MILES ET AL.

Examiner

REGINALD A. RENWICK

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-100)
Paper No(s)/Mail Date 09/29/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 7-9, 11, 18-28, 30, 33, 3-40, 47-49 53, 54, 55, and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Barrie (U.S. Patent No. 5,833,537).

Re claims 1, 20, and 37: Barrie discloses a gaming device comprising:

a primary game including a plurality of reels having a plurality of symbols, at least one of said symbols including a modifier activator symbol (Abstract) ;

a plurality of different modifiers, each one of the modifiers corresponding to a plurality of activations of the reels; at least one display device; at least one processor (column 2, lines 38-41); and at least one memory device which stores a plurality of instructions (column 4, lines 48-50), which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device (column 4, lines 62-67; column 5, lines 1-2) to:

(a) activate the reels and display at least one of said symbols (column 1, lines 16-20);

(b) provide any award based on the at least one displayed symbol (column 1, lines 32-36; column 3, lines 11-35);

- (c) determine whether at least one of the modifier activator symbols is displayed on the reels (column 5, lines 66-67; column lines 1);
- (d) select the modifier corresponding to the determined modifier activator symbol (column 6, lines 1-5);
- (e) reactivate the reels one or more times (column 1, lines 4-7; column 6, lines 10-24);
- (f) apply the selected modifier to modify at least one function of the primary game for each one of the reactivations of the reels (column 6, lines 10-24); and
- (g) provide any award based, at least in part, on the selected modifier (column 6, lines 10-24).

Re claims 2 and 21: Because Barrie discloses that multiple modifier indicator symbols have different values (x and 5x), it is inherent of Barrie to incorporate a plurality of said symbols that are modifier activator symbols.

Re claims 3 and 22 (previously presented): Barrie discloses an embodiment in which persistent modifier activator symbols are present for a plurality of activations wherein the persistent symbols are associated with a modifier, whereby one of those modifiers are selected when a player achieves a winning combination on the payline where the persistent modifier activator is located (Fig. 1, Fig. 1A; column 4, lines 8-22).

Re claims 4 and 23: Because multiple modifier symbols are applicable to the game of play Barrie discloses that the instructions including a plurality of instructions executable

to cause the at least one processor to select more than one modifier (Fig. 1, Fig 1A; column 4, lines 23-35) whereby the modifier is selected by the reels when there are multiple winning combinations are displayed. Barrie further adds that a persistent symbol need not to stay in one location and depending upon the game machine operations, can move to other locations resulting in selecting another modifier (column 9, lines 39-46).

Re claims 5 and 24: Barrie discloses that the instructions including a plurality of instructions executable to cause the at least one processor to apply a plurality of selected modifiers to modify a plurality of functions of the primary game wherein a plurality of functions includes the payout of the first payline, second, and third payline (column 5, lines 66-67; column 6, lines 1-5).

Re claims 6, 25, 40, 49: Barrie discloses indicating the age of each of the active modifier for a plurality of subsequent plays (column 5, lines 3-5).

Re claims 7 and 26: The persistent effect symbol of Barrie begins by causing the at least one processor to select one of the plurality of modifiers if said modifier activator symbol is displayed and no modifiers are currently activated (Abstract).

Re claims 8 and 27: Barrie discloses that the modifier generator displayed to the player that includes said plurality of modifiers (Abstract; Fig. 1; Fig. 4; column 4, lines 65-67;

column 5, lines 1-3).

Re claims 9 and 28 (previously presented): Barrie discloses that the instructions including a plurality of instructions executable to cause the at least one processor to operate with the modifier generator to select at least one of the plurality of modifiers, wherein the modifier is selected when a modifier appears on the same payline as the selected modifier (column 6, lines 5-16), and also a modifier is selected when a winning combination appears on the payline with the modifier whereby the modifier is activated to affect the payout (Abstract).

Re claims 11 and 30: Barrie discloses that said selected modifier is activated if said modifier activator symbol is displayed (Fig. 1a, Fig. 4; column 6, lines 5-8).

Re claims 18, 38, and 47: The claim language of claim 18, is significantly discussed above in claim 1. However, claim 1 does not disclose to select one of the plurality of modifiers after the modifier activator is indicated on the reels. However, Barrie discloses selecting from a plurality of already displayed modifiers, the modifier that is in alignment with the payline of the modifier indicator (column 6, lines 5-23). Furthermore Barrie discloses selecting more than one modifier (Fig. 1, Fig 1A; column 4, lines 23-35) whereby the modifier is selected by the reels when there are multiple winning combinations are displayed. Barrie further adds that a persistent symbol need not to stay in one location and depending upon the game machine operations, can move to

other locations resulting in selecting another modifier (column 9, lines 39-46).

Re claim 19: Barrie discloses that the triggering event is the player making a wager on the primary wagering game (column 1, lines 25-32).

Re claim 33: Barrie discloses that modifier generator includes a modifier reel (Abstract).

Re Claim 39: Because Barrie discloses that multiple modifier indicator symbols have different values (x and 5x), it is inherent of Barrie to incorporate a plurality of said symbols that are modifier activator symbols.

Re Claim 44 (previously presented): Barrie discloses more than one modifier is activated for at least one subsequent activation of the reels (Abstract).

Re Claim 45 and 53: Barrie discloses that the method provided to the player through a data network (column 4, lines 50-60).

Re Claims 46 and 54 (previously presented): Barrie discloses that the data network is an internet (column 4, lines 50-60).

Re claim 48: Barrie discloses that at least one of the plurality of modifiers is selected if the player obtains at least one modifier activator in one of the subsequent plays of the

primary wagering game (column 6, lines 8-23)

Re claim 55 (previously presented): Barrie discloses that the at least one function including at least one primary game outcome wherein a payout multiplier is applicable to a plurality of feature game outcomes (Abstract).

Re claim 56 (previously presented): Barrie discloses that the at least one function including at least one primary game award (Abstract).

Claim Rejections - 35 USC § 103

4. Claim 16, 17, 35, 36, 42, 43, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie.

Re claim 16 (previously presented): Because Barrie discloses that there are a plurality of modifiers wherein each modifier has a stated lifespan for a subsequent activations (Abstract; column 5, lines 1-26), the added limitation stating that said modifier is associated with the same plurality of subsequent activations of the reels, does not incorporate added structural functionality into the invention, and it would have been obvious to one skilled in the art simple matter of design choice as said limitation is a game configuration using game elements.

Re claim 17 (previously presented): Because Barrie discloses that there are a plurality of modifiers wherein each modifier has a stated lifespan for a subsequent activations (Abstract; column 5, lines 1-26),, the added limitation stating that a plurality of said modifiers are each associated with a different pluralities of subsequent activations of the reels, does not incorporate added structural functionality into the invention, and it would have been obvious to one skilled in the art simple matter of design choice as said limitation is a game configuration using game elements.

Re claims 36, 42, and 51 (previously presented): Because Barrie discloses that there are a plurality of modifiers wherein each modifier has a stated lifespan for a subsequent activations, the added limitation stating that said modifier is associated with the same plurality of subsequent activations of the reels, does not incorporate added structural functionality into the invention, and it would have been obvious to one skilled in the art simple matter of design choice as said limitation is a game configuration using game elements.

Re claims 35, 43, and 52 (previously presented): Because Barrie discloses that there are a plurality of modifiers wherein each modifier has a stated lifespan for a subsequent activations, the added limitation stating that a plurality of said modifiers are each associated with a different pluralities of subsequent activations of the reels, does not incorporate added structural functionality into the invention, and it would have been

obvious to one skilled in the art simple matte

3. Claims 10, 12, 13, 14, 29, 31, 32, 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of DeSimone (U.S. Patent No. 6,,558,253).

Re claims 10, 12, 13, 14, 29, 31, 32, 34 (previously presented): Barrie fails to disclose that the modifier generator selects a modifier if no modifier is currently activated. Furthermore, Barrie fails to disclose that a modifier is selected for each activation of the reel. However, DeSimone discloses that a multiplier selector generator is operable at anytime during game play for generating a multiplier, and can be applied when retrieved by the gaming unit (column 25, lines 15-18) and one skilled in the art can start the multiplier selector generator at the start of every game. It would have been obvious to one skilled in the art to combine the teaching of loading a multiplier at the start of every game as taught by DeSimone with the invention of Barrie for the purpose of reducing the time between when a multiplier bonus is activated by the game reels and when the multiplier bonus is displayed by the game machine.

4. Claims 15, 41, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Webb (U.S. Patent No. 6,632,141).

Re claims 15, 41, and 50: Barrie fails to disclose that the player selects the modifier after a triggering symbol. However, Webb discloses such (Abstract). Barrie discloses a

persistent modifier in the form of a multiplier is caused by a triggering event and as a result the modifier generator selects the modifier symbol. Because both Barrie and Webb disclose methods for selecting bonus multipliers for effecting the outcome of a game session, it would have been obvious to one skilled in the art, to simply substitute the method of Barrie for generating a modifier, for the method of Webb for the purpose of adding excitement to the game by making the game more interactive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD A. RENWICK whose telephone number is (571)270-1913. The examiner can normally be reached on Monday-Friday, 7:30AM-5:00PM, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry. Suhol/
Supervisory Patent Examiner, Art
Unit 3714

12/09/2008
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Examiner, Art Unit 3714